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In re Application of Willars et al. : Decision on Petition
Application No. 09/286,471 :
Filing Date: April 6, 1999 :
Attorney Docket No. 2380-122 :
:

This is a decision on the petition filed July 5, 2005, which is being taken as a request under 37 CFR 1.181(a)(3) for review of the improper merger of the instant application with application number 09/283,919.

The petition is **granted**.

Facts:

Petitioner filed application no. 09/283,919 ("Application 1") on April 1, 1999.

Petitioner filed application no. 09/286,471 ("Application 2") on April 6, 1999.

The contents of Application 2 are similar to Application 1.

Petitioner intended to prosecute Application 2 and allow Application 1 to become abandoned.

A Notice to File Missing Parts was mailed for Application 2 on April 28, 1999. The Notice required the submission of \$998 and an executed oath or declaration.

A Notice to File Missing Parts was mailed for Application 1 on May 5, 1999. The Notice required the submission of \$962 and an executed oath or declaration.

On June 9, 1999, Petitioner responded to the Notice to File Missing Parts mailed for Application 2. The response included the required \$998, an executed declaration, and a copy of the Notice to File Missing Parts. The declaration states it applies to U.S. Application Serial No. 09/286,471 (Application 2) filed on April 6, 1999.

On June 10, 1999, the Office correctly applied the \$998 to Application 2.

On August 12, 1999, the Office recorded the assignment for Application 2 and mailed a Notice of Recordation.

Petitioner did not respond to the Notice to File Missing Parts mailed for Application 1.

On an unknown date, an unknown employee incorrectly decided Application 1 and Application 2 should be merged into a single application. The following papers were removed from Application 2's file jacket and placed in the file jacket for Application 1:

Filed April 6, 1999:

1 page transmittal sheet,
1 page title sheet,
32 pages of specif. including 6 pages of claims and 1 page of abstract,
17 sheets of drawings, and
1 IDS and copy of 10 references.

Mailed April 28, 1999:

Notice to File Missing Parts

Filed June 9, 1999:

Response to Notice to File Missing Parts
Declaration

Created July 10, 1999:

Notice of Draftperson's Patent Drawing Review

Filed December 10, 1999:

IDS and copy of 1 reference

On September 14, 2000, the fees paid for Application 2 were transferred and applied to Application 1.

On January 4, 2001, a Supplemental Declaration was filed for Application 2. A copy of the Supplemental Declaration was not matched with the file for Application 1 and cannot be located. The Office has made a copy of the Supplemental Declaration and transmittal sheet filed with the petition to use when processing the application.

On July 5, 2001, a non-final Office action was mailed for Application 1. Petitioner had no reason to respond to the Office action since petitioner did not wish to prosecute Application 1. Petitioner did not file a response.

On October 8, 2001, petitioner filed a Status Inquiry. The Office responded and stated an expected date of action by the examiner for Application 2 was November of 2001.

On October 8, 2002, a second Status Inquiry was filed. The Office mailed a response stating, "We project that this application will be first examined in 0 to 3 months from today."

On October 7, 2004, a third Status Inquiry was filed. The Office did not mail a response.

Petitioner has supplied a copy of a PAIR printout dated July 7, 2005. The printout indicates:

- (1) The application was dispatched from OIPE on June 18, 1999.
- (2) The case was docketed to an examiner on July 30, 1999.
- (3) The case was docketed to an examiner on October 6, 2000.
- (4) The case was docketed to an examiner on April 8, 2003.
- (5) A "Duplicate case" was deactivated on April 8, 2004.

On July 5, 2005, Petitioner filed a "Petition Requesting Action on Application" for Application 2. The Petition was simply placed in the file wrapper for Application 1 and was not forwarded to the Office of Petitions.

The instant "Renewed Petition Requesting Action on Application" was filed May 22, 2006. The Petition was simply placed in the file wrapper for Application 1 and was not forwarded to the Office of Petitions.

Discussion:

The record fails to indicate the instant application should be considered inactive or abandoned.

The record fails to indicate the Office acted properly in merging the instant application with application number 09/283,919.

The Office has scanned all papers for the instant into an Image File Wrapper (IFW) for the application.

The Office of Initial Patent Examination (OIPE) will be informed of the instant decision. OIPE will process the instant application under application number 09/286,471 with a filing date of April 6, 1999. OIPE will also transfer all fees from 09/283,919 to 09/286,471.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
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Office of Petitions